

REMARKS

Upon entry of the present amendment, claims 1-7 will remain pending in the above-identified application and stand ready for further action on the merits. Claims 1 and 2 are amended. No new matter has been introduced by way of the present amendment. The currently amended Claim 1 is support by the present specification, for instance, see page 16, lines 8-19. In Claim 2, the phrase "bent substantially at a right angle" is deleted. Accordingly, no new matter has been introduced.

*Claim Rejections - 35 U.S.C. §103*

Claims 1-5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rodgers et al. US '737 (US 6,362,737) in view of Hirai et al. US '526 (US 6,160,526).

Claims 6-7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rodgers et al. US '737 as modified by Hirai et al. US '526 as applied to Claim 1, and further in view of Sanders US '523 (US 6,276,523).

Reconsideration and withdraw of each of these rejections is respectfully requested based on the amendments made herein to the pending claims and the following considerations.

*Incorporation of Earlier Remarks*

The Examiner is respectfully requested to review remarks set forth at pages 5-13 of the prior reply of December 19, 2006 as they contain comments that remain material to the Examiner's consideration of the patentability of pending claims 1-7 as they have been amended herein.

As such, the Examiner is respectfully requested to review said earlier filed remarks at this time, and moreover said earlier filed remarks of December 19, 2006 are "*incorporated herein by reference in their entirety*" for the Examiner's consideration at present.

*Legal Standard for Determining Prima Facie Obviousness*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Yaeger*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Ronffel*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_\_, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and

(d) evaluating evidence of secondary consideration.

*Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc., supra*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc., ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

#### *The Present Invention and its Advantages*

The present invention has an object of providing of an accessed object containing a non-contact IC module that includes an IC chip and a radio communication antenna coil connected to the semiconductor device. The radio communication antenna coil is a continuous conductive wiring pattern bent to extend over two surfaces of different direction. Further, the conductive wiring pattern includes a large and a small module side antenna with the small module side antenna located close to a first side edge. Furthermore, the IC chip is inside the radio communication antenna coil.

The radio communication antenna, being a continuous conductive wiring pattern, allows the IC module in the present invention to be formed on a flexible sheet, such as polyethylene terephthalate films or polyimide film (e.g., *see* page 10, lines 22-27 and Figures 4-5). The continuous conductive wiring pattern also ensures that the small and large module side antennae have the same winding direction. *See*, for instance, page 21, lines 5-10 and Figure 26. Also, the continuous conductive wiring pattern with the small and large module side antennae with the same winding direction on at least two surfaces of different directions enhances the handlability of the accessed object. *See* page 3, line 19 to page 4, line 5 and Figure 3.

Furthermore, the IC chip is inside the radio communication antenna coil.

*Distinctions Over the Cited Art*

The present invention is distinguishable from Rodgers et al. US '737. Rodgers et al. US '737 teaches two coils 3708 and 3716 cooperating with each other as shown in Fig. 37 and explained in columns 54-55 thereof. Coils 3708 and 3716 are two separate coils and are connected two different capacitors 3710 and 3714. As such, it is submitted that the Rodgers et al. US '737 disclosure, and moreover, any one of the two coils 3708 and 3716 of Rodgers et al. US '737 do not allow one of ordinary skill in the art to reach the recited feature in instantly amended claim 1 of:

*...a continuous conductive wiring pattern bent to extend over two surfaces of different directions of said accessed object, and comprising a large and small module side antenna, the small module side antenna locating close to a first side edge, wherein said IC chip is inside the radio communication antenna coil.*

Accordingly, it is submitted that Rodgers et al. US '737 fails to disclose or in any other way provide for an important aspect of the instant invention as claimed. It is likewise submitted that Rodgers et al. US '737 further fails to provide any teaching that would lead one of ordinary skill in the art to arrive at the instant invention as claimed (including all of the limitations recited therein (e.g., *see* claim 1)).

The Examiner attempts to cure the noted deficiencies of Rodgers et al. US '737 by citing Hirai et al. US '526 as a secondary reference. However, Hirai et al. US '526 is incapable of curing the deficiencies of Rodgers et al. US '737, since it also neither teaches nor discloses the recited feature in instantly amended claim 1 of:

*...a continuous conductive wiring pattern bent to extend over two surfaces of different directions of said accessed object, and comprising a large and small module side antenna, the small module side antenna locating close to a first side edge, wherein said IC chip is inside the radio communication antenna coil.*

As such, it is submitted that Claims 1-5 are fully patentable over the cited combination of Rodgers et al. US '737 in view of Hirai et al. US '526.

Similarly, it is submitted that instantly pending claims 6 and 7 are patentable under 35 U.S.C. §102(a) over Rodgers et al. US '737 as modified by Hirai et al. US '526 further in view of Sanders US '523. In this regard, the cited secondary reference of Sanders US '523 is also incapable of curing the above-noted deficiencies in the cited primary reference of Rodgers et al. US '737. As such, its combination with the Rodgers et al. US '737 reference (and/or Hirai et al. US '526) is incapable of leading one of ordinary skill in the art to arrive at the invention recited in pending claims 6-7.

In view of the above comments, Applicants respectfully submit that the present claims 1-7 define allowable subject matter.

Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims. Likewise, any contentions of the USPTO to the contrary are unsustainable and must be reconsidered at present.

### CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-7 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated:

JULY 7 2007

Respectfully submitted,

By   
John W. Bailey  
Registration No.: 32,881  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant